

REMARKS

Claims 1, 8-12, 17-24, 28-32, 34-36, 38, 40, and 41 are pending in the application with claims 18-24, 28-32, 34-36, 38, 40, and 41 withdrawn from consideration. Despite Applicant's traversal of the restriction requirement, the Office deemed the requirement proper and made it final. Applicant herewith submits a petition from the requirement for restriction under 37 CFR 1.144 requesting consideration of claims 34-36, 38, 40, and 41.

Claims 1, 8-10, and 17 stand rejected under 35 USC 102(b) as being anticipated by Vanbesien (US Patent 6,562,541). Claims 11 and 12 stand rejected under 35 USC 103(a) as being unpatentable over Vanbesien in view of Grande (US Patent 6,162,573). Applicant requests reconsideration.

Claim 1 sets forth a liquid toner including, among other features, a carrier liquid, toner particles containing a resin, and substantially uncolored additive particles of average diameter between 1 and 20 micrometers dispersed in the resin. The additive particles make at least 10% of the toner particles. The additive particles contain one or more of listed polymers. Pages 2-3 of the Office Action allege that Vanbesien discloses each and every limitation of claim 1. Applicant traverses.

Page 2 of the Office Action alleges that Vanbesien discloses a toner particle mixed with a carrier particle. However, claim 1 sets forth "a carrier liquid." Applicant asserts that Vanbesien does not disclose and the Office Action does not allege that it discloses a liquid toner containing a carrier liquid, as set forth in claim 1. The Office Action does not include any

reasoning supporting a conclusion that the cited reference somehow discloses a carrier liquid. Reference to the last eight lines of each of Examples I-VI in Vanbesien reveals that, without exception, all of the examples describe a dry toner, which is known not to include a carrier liquid. Consequently, no support exists for the Office's allegation that Vanbesien discloses each and every limitation of claim 1. At least for such reason, claim 1 is patentable.

Pages 2-3 of the Office Action allege that Vanbesien discloses a polyethylene wax that may be present in an amount up to 30%, referring to column 14, line 66 to column 15, line 2 of Example I. The referenced text describes an aqueous anionic wax dispersion of P 725, a polypropylene wax. Notably, claim 1 sets forth a polyethylene wax, which is a different chemical. Further, the referenced text merely states that the polypropylene wax has a solids content of 31 percent. Review of the remainder of the paragraph in Example I reveals at page 15, lines 38-39 that the resulting toner only includes 8% of P 725 wax. As such, no support exists for the Office's allegation that Vanbesien discloses each and every limitation of claim 1. At least for such additional reason, claim 1 is patentable.

Page 3 of the Office Action alleges that the PTFE of Vanbesien describes a size diameter of 50-120 nanometers. However, the referenced text does not support the Office's allegation that Vanbesien discloses the "substantially uncolored additive particles of average diameter between 1 and 20 micrometers dispersed in the resin," as set forth in claim 1. Notably,

1 micrometer is equivalent to 1000 nanometers. Description in Vanbesien of a size diameter of 50-120 nanometers cannot be considered to disclose the claimed average diameter of additive particles, which is roughly 10 times larger. Applicant notes that at least page 3, lines 4-30 and page 13, lines 3-8 of the present specification describe the significance of particle diameter in the claimed liquid toner. At least for such further reason, claim 1 is patentable.

Claims 8-12, 17, 34-36, 38, 40, and 41 depend from claim 1 and are patentable at least for such reason as well as for the additional limitations of such claims not disclosed or suggested. Grande does not remedy and is not alleged to remedy the deficiencies of Vanbesien discussed above.

For example, claim 10 sets forth that the additive particles make up at least 40% by weight of the toner particles. As discussed above, the Office improperly alleges disclosure of up to 30% polyethylene wax, which, even if supported, would be insufficient to anticipate claim 10. As also discussed above, the Office's evidence only supports description of 8% polypropylene wax. Thus, claim 10 is patentable.

Also for example, claim 17 sets forth that the toner particles of claim 1 contain a first resin and the additive particles contain a second resin that is incompatible with the first resin. Page 3 of the Office Action refers to column 6, lines 55-58 of Vanbesien, which describes optionally adding a second latex comprised of resin particles to the toner aggregates. The referenced text does not support the Office's allegation that Vanbesien

discloses the claimed toner particles containing a first resin along with additive particles dispersed in the first resin and containing a second resin that is incompatible with the first resin. Vanbesien does not disclose and the Office Action does not allege that it discloses any incompatibility between resins. As a result, no support exists for rejection of claim 17.

Applicant herein establishes adequate reasons supporting patentability of claims 1, 8-12, 17, 34-36, 38, 40, and 41 and requests allowance of all such pending claims in the next Office Action.

Respectfully submitted,

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